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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,449	03/30/2001	Tg Hien	3COM-3228.US.P	5704

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EXAMINER

ST CYR, DANIEL

ART UNIT PAPER NUMBER

2876

DATE MAILED: 09/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/823,449

Applicant(s)

HIEN ET AL.

Examiner

Daniel St.Cyr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/12/04.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-13, 15, 16 and 18-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-13, 15, 16 and 18-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. This is in response to the applicant response filed 7/12/04.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 9-13, 15, 16, 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harari et al, US Patent No. 5,887,145.

Re claims 1, 10, and 21, Harari et al discloses a removable mother/daughter card comprising: a first module 10 (the card serves as a communication device) having an opening, said first module adapted to be communicatively coupled with an electronic device 200, said first module adapted to receive a second module 20; a controller 40 coupled with said first module for controlling communication between said first and second module; a first module electrical connector 12 to communicate with said electronic device; and a second connector coupled with the first module for communicating with the second module (see figures 1-3 and col. 6, line 59 +).

Re claims 2, 11, and 22, wherein the first module is adapted to be inserted into said accessible slot of said electronic device (see figure 1).

Re claims 3 and 12, wherein said opening of said first module is adapted to receive said module (see figure 1).

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Re claim 4, 13, 23, wherein said first and second modules are communication memory devices (figure 3).

Re claims 15 and 16, wherein the memory device is digital multimedia card (see figure 4).

Harari et al disclose that components necessary for implementing wireless functionality (wireless modem) are on the daughter card and disclose that the use of a peripheral modem requires functional components on both the mother card and the daughter card (see applicant argument on page 13, line 11+). Therefore for implementing wireless functionally would also require the wireless component to be placed in the mother card also.

It would have been obvious for a person of ordinary skill in the art at the time the invention was made to modify the system of Harari et al so that the cards can could communicate wirelessly. Such modification would make the system more effective and more convenient wherein data would be communicate without having the card being physically connected. Therefore, it would have been an obvious extension as taught by Harari et al.

Re claim 9 and 20, Harari et al fails to disclose or fairly suggest that the opening of the first module is larger than accessible slot of electronic device. However, such limitation is an obvious engineering design choice to meet customers' requirements, failing to provide any unexpected results. Furthermore, these types of connection combinations are notoriously old and well known in the art. Therefore, it would have been an obvious extension as taught by Harari et al.

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4. Claims 7, 8, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harari et al in view of Nelson et al, US Patent No. 6,377,218. The teachings of Harari et al have been discussed above.

Harari et al teach that the communication device could be a modem (see col. 8, line 45), but fail to disclose or fairly suggest that the modem is a Bluetooth wireless modem.

Nelson et al disclose a device for providing an antenna, a receptacle, and physical connector on a type II PCMCIA card comprising a radio frequency device 200 wherein the device is a Bluetooth wireless device (see col. 3, line 60+ and col. 4, line 34+).

In view of Nelson et al's teachings, it would have been obvious for a person of ordinary skill in the art at the time the invention was made to modify the modem device of Harari et al into a Bluetooth wireless modem to provide connection to remote network. Such modification would facilitate connection to existing data networks by providing a bridge mechanism to interface with the data networks. Furthermore, the Bluetooth modem would be able to process communication inquiries and requests without involving the host system, which would make the system more effective. Therefore, it would have been an obvious extension as taught by Harari et al.

Response to Arguments

5. Applicant's arguments filed 7/12/04 have been fully considered but they are not persuasive. (see the examiner remarks).

REMARKS:

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e.,

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communication that operates independently) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, it is not clear as to what the applicant means by “operating independently”.

In response to the applicant’s general argument that the prior art does not disclose the claimed invention, the examiner respectfully disagrees. It is clearly illustrated above how the prior art meets the claimed limitations. The applicant’s argument is not persuasive. Refer to the rejection above.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel St.Cyr whose telephone number is 571-272-2407. The examiner can normally be reached on Mon-Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel St.Cyr
Primary Examiner
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A handwritten signature in black ink, appearing to read 'Daniel St. Cyr', is written over a horizontal line.

DS
September 10, 2004